

Remarks

Amendments to the Specification

In the specification, the paragraphs 0001-0002, 0007-0010, 0012-0014, 0018, 0021, 0023-0024, and 0026-0028 have been amended to correct minor editorial problems.

Objections to the Specification

The Examiner objected to the specification under 37 CFR § 1.75 (d)(1) for failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner objects as follows:

First, the specification fails to provide support for the feature “thereby leaving no fingerprints on the area of the preparation” claimed in Claim 14. Applicant has amended Claim 14 to delete this claim limitation thereby rendering this objection moot. Applicant respectfully requests withdrawal of this objection.

Second, the specification fails to provide support for the feature “the printed characters and the printed representation of the preparation are done in one color” as recited in Claim 16 and the further claim limitation in Claim 17 wherein the one color is black. Applicant has amended paragraph 0023 to refer to Figure 6 in which a barcode is represented as one form of printed character. It is well known in the art that barcodes are preferably printed in one color, usually black. Applicant respectfully requests withdrawal of this objection.

Third, the specification fails to provide support for the feature “the printed representation of is printed in color on the sticker.” as recited in Claim 20. Applicant has amended paragraph 0020 of the instant application to include the limitation of printing the sticker in color. Applicant respectfully requests withdrawal of this objection.

Fourth, the specification fails to provide support for the feature “the sticker is printed separately and is attached after the printing process to the microscope slide.” as recited in Claim 21. Applicant has amended paragraph 0020 to refer to Figure 3 in which a printed sticker 22 with adhesive (reference no. 25) is shown in the midst of attachment to slide 8. Applicant respectfully requests withdrawal of this objection.

Objections to the Claims

The Examiner objected to Claims 18 and 22 due to editorial informalities. Applicant has deleted the language “the rectangular slide” in both Claims 18 and 22. Applicant respectfully requests withdrawal of these objections to Claims 18 and 22.

Amendments to Claims

The following amendments to claims have been made as follows to correct editorial or procedural errors:

Claims 6, 8, and 9 have been amended to depend from amended independent Claim 1;

Claim 14 has been amended to maintain consistency with the claim language of amended Claim 1 from which it depends;

Claim 15 has been amended to maintain consistency with the term “layer” which had been use interchangeably with the deleted term “coating”;

Claim 20 has been amended to change to spelling of the word “colour” to “color”;

These amendments have not been made for reasons related to the patentability of any of the above claims.

The § 102 (b) Rejections of Claims 1-4 and 14

The Examiner rejected Claims 1-4 and 14 under 35 U.S.C. § 102 (b) as anticipated by United States Patent No. 5,561,556 to Weissman (“Weissman” of “the Weissman patent”). Applicants have amended independent Claim 1 and respectfully traverse the rejection of those claims and request reconsideration.

Applicant has amended Claim 1 by including the claim limitations of Claims 5 and 7. Thus, amended Claim 1 includes two nontransparent areas on the claimed slide. One of the nontransparent areas supports a printed representation of the preparation or specimen carried on the slide while the other nontransparent area supports printed characters. Applicant courteously points out that Weissman fails to disclose a slide with a nontransparent layer as is claimed in

Claim 1 and described throughout the instant application. (See, for example, Paragraph 0018 describing a nontransparent layer 14 carrying a plurality printed characters.) Applicant notes further that Weissman fails to disclose a slide that the supports a representation of the specimen or preparation supported by the slide. A claim is anticipated only if a single reference discloses all the limitations of the rejected claim. As seen above, Weissman fails to disclose both a second nontransparent area and a representation of the specimen as claimed in Claim 1 and thus fails to anticipate amended Claim 1. Applicant respectfully requests withdrawal of the rejection of amended Claim 1 and passage to allowance of that claim.

Claims 2-4 and 14 depend from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Weissman patent fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 2-4 and 14. Applicant respectfully requests the removal of the rejections of Claims 2-4 and 14 and passage to allowance of those claims.

The § 103 (a) Rejections of Claims 10-13 (Weissman/Speelman)

The Examiner rejected Claims 10-13 as unpatentable under 35 U.S.C. § 103 (a) as obvious over the Weissman patent in view of United States Patent No. 3,672,745 to Speelman ("Speelman" or "the Speelman patent"). Applicants respectfully traverse this rejection and request reconsideration.

To establish a *prima facie* case of obviousness, the reference(s) must teach or suggest all limitations of the claim at issue. The teaching or suggestion to make the combined combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant courteously points out that Claims 10-13 depend from amended Claim 1 and thus incorporate all the limitations of that claim. Specifically, Claims 10-13 include the claim limitation of two nontransparent areas on the slide claimed in amended independent Claim 1. As seen in the discussion above, the Weissman patent discloses a slide that possesses a label that may block light but does not disclose, teach, or suggest a nontransparent layer per se. It is evident that Weissman does not ever discuss in the text or show in the drawings two nontransparent areas on

a slide. Similarly, the Speelman patent is directed to a beveled edge microscope slide and does not mention any nontransparent area on the slide, let alone two such nontransparent areas. Therefore, the combined references of Weissman and Speelman fail to establish a *prima facie* case of obviousness against Claims 10-13 as those references fail to teach or disclose all the limitations of those claims. Applicant respectfully requests withdrawal of the rejection and passage to allowance of those claims.

The § 103 (a) Rejections of Claims 1-6 and 14

The Examiner rejected Claims 1-6 and 14 under 35 U.S.C. § 103 (a) over United States Patent No. 5,111,344 to Robinson, Jr. ("Robinson" or "the Robinson patent") in view of United States Patent No. 5,963,368 to Domanik ("Domanik" or "the Domanik patent"). Applicant has cancelled Claim 5 thereby rendering the rejection of that claim moot. Applicant respectfully traverses these rejections of Claims 1-4, 6 and 14 and requests reconsideration.

As noted above, to establish a *prima facie* case of obviousness, the reference(s) must teach or suggest all limitations of the claim at issue. The teaching or suggestion to make the combined combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully notes that Claims 2-4, 6, and 14 depend from amended independent Claim 1 and thus incorporate all the limitations of that amended claim. Applicant also takes note of the Examiner's remark that the Robinson patent does not clearly disclose that printed information is provided on the marking (nontransparent) surface of the slide as claimed.

Applicant respectfully traverses the Examiner's statement that the Domanik patent discloses a slide having three areas, two of which support printed information. Applicant courteously refers the Examiner to Figure 3 and col. 3, lines 9-19 in the Domanik patent which clearly describes specimen 12 as including "elongate slide 14, a biological sample 16 and cover slip 18 which overlays sample 16." Therefore, reference no. 18 in Domanik is not a separate area as described by the Examiner but rather a component that is not even an integral part of the

slide and is certainly not used to support information printed on the slide. Moreover, Domanik does not suggest, teach or discloses the use of any nontransparent areas on a slide to support printed or readable material, let alone the use of two separate nontransparent areas as is claimed in amended Claim 1. Therefore, because the combined references of Robinson and Domanik fail to disclose or suggest the use of nontransparent areas on a microscope slide to support printed information, Applicant respectfully traverses these rejections and requests reconsideration.

"If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2-4, 6 and 14 depend from amended Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Robinson and Domanik patents together fail to render obvious all the elements of Claim 1, it also fails to render obvious Claims 2-4, 6 and 14. Applicants respectfully request the removal of the rejections of Claims 2-4, 6 and 14 and passage to allowance of those claims.

The § 103 (a) Rejections of Claims 7-9 and 15-22

The Examiner has rejected claims 7-9 and 15-22 under 35 U.S.C. § 103 (a) as obvious over Robinson in view of Domanik and further in view of United States Patent No. 5,598,295 to Olofson ("Olofson" or "the Olofson patent"). Applicant has cancelled Claim 7 thereby rendering the rejection of that claim moot. Applicant respectfully traverses the rejection of Claims 8-9 and 15-22 and requests reconsideration.

Applicant notes that Claims 8 and 9 depend from amended independent Claim 1 and thus incorporate the limitations of that claim including two separate nontransparent areas of a slide, one of which supports printed readable information and the other of which supports a presentation of the specimen under examination. Independent Claim 15, from which Claims 16-18 depend, also claims two nontransparent areas supporting information. Finally, independent Claim 19 from which Claims 20-22 depend, claims a slide with one nontransparent area and a second area supporting sticker with a printed representation of the specimen on the slide.

Applicant courteously notes the Examiner's statement that Robinson and Domanik fail to disclose the use of nontransparent areas to support information readable by a machine or human being and a second surface to support a representation of the sample carried by the microscope slide. Applicant respectfully traverses the Examiner's statement that Olofson discloses the use of two nontransparent marking surfaces both of which support information as claimed by Applicant. Applicant courteously points out that coating 16 in Olofson is only disclosed as being deposited on the opposite side of coating 14. This is critical to the functioning of the Olofson disclosure because, in fact, coating 16 is not used to support information by itself, but is used as a contrasting background to make visible markings scribed into coating 14. See col. 3, lines 1-13 in which coating 14 is described as scratchable "such that it can be removed by scribing with a pointed scribe 26 as shown in Fig. 3. Upon scribing scratchable coating 14 with a pointed scribe 16, coating 14 is removed where scribed at indicia 28 from respective side 18 of slide 10 so that contrastingly colored coating 16 is visible from side 20 of slide 10 at the scribed area." (Olofson, col. 3, lines 3-8.) Thus, the second nontransparent area of Olofson does not support information of any type but only acts a contrasting color agent to make scribed markings more visible. Therefore, it is readily seen that, in fact, Olofson does not disclose the use of two marking surfaces that is claimed by Applicant. In addition, as noted above, Domanik also fails to disclose or suggest two different marking areas, let alone any type of nontransparent areas at all. Consequently, regarding Claims 8-9 and 15-18, the combined references of Robinson, Domanik and Olofson fails to establish a *prima facie* case of obviousness as they together fail to disclose, suggest or teach all the limitations of those claims, namely two nontransparent areas of a slide, both of which support readable information or to suggest the combining the teachings of those references to render Claims 8-9 and 15-18 obvious. Regarding Claims 19-22, the combined Robinson, Domanik, and Olofson references again fail to establish a *prima facie* case of obviousness as they fail to disclose two different areas that both support readable information. Therefore, Applicant respectfully traverses these rejections of claims 8-9 and 15-22 and requests reconsideration and passage to allowance of those claims.

The § 103 (a) Rejections of claims 10-13 (Robinson/Domanik/Speelman)

The Examiner rejected Claims 10-13 under 35 U.S.C. § 103 (a) as obvious over Robinson, et al. in view of Domanik and further in view of Speelman. Applicant respectfully traverses these rejections and requests reconsideration.

Applicant notes that claims 10-13 depend from amended Claim 1 and thus incorporate all the limitations of that claim. To establish a *prima facie* case of obviousness, the reference(s) must teach or suggest all limitations of the claim at issue. The teaching or suggestion to make the combined combination must be found in the prior art, and not based on Applicant's disclosure. While Speelman discloses beveled slide edges as claimed in Claim 10, Speelman fails to disclose the use of two nontransparent areas used to support printed and/or readable material as claimed in Claims 10-13. As noted by the Examiner, Robinson does not clearly disclose printed material that is provided on the marking surface of the slide as claimed in Claims 10-13. Further, as discussed above, Domanik fails to disclose a nontransparent area of any type and also fails to suggest either a second nontransparent area or a second area on a slide that to be used to support printed material. Thus, together, the Robinson, Domanik, and Speelman patents fail to both disclose all the limitations of Claims 10-13 and to provide any motivation to combine those references to establish a *prima facie* case of obviousness against Claims 10-13. Applicant respectfully requests reconsideration and passage to allowance to Claims 10-13.

Attorney Docket No. LEAP:129US
U.S. Patent Application No. 10/698,506
Reply to Office Action of September 15, 2004
Date: December 15, 2004

Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "C. Richard Lohrman".

C. Richard Lohrman
Registration No. 46,878
ATTORNEY FOR APPLICANT
Simpson & Simpson PLLC
Customer No. 24041
5555 Main Street
Williamsville, NY 14221
Phone: (716) 626-1564
Fax: (716) 626-0366

Dated: December 15, 2004